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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,692	10/25/2001	Griffith D. Neal	8864/29	3164

7590 04/29/2004

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EXAMINER

KIM, PAUL D

ART UNIT PAPER NUMBER

3729

*17*

DATE MAILED: 04/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/001,692

Applicant(s)

NEAL ET AL.

Examiner

Paul D Kim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 08 April 2004.
- 2a)  This action is **FINAL**.
- 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-60 is/are pending in the application.
  - 4a) Of the above claim(s) 1-31, 34-40 and 43-45 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) \_\_\_\_\_ is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) 32, 41, 42 and 46-60 are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a)  All b)  Some \* c)  None of:
      - 1.  Certified copies of the priority documents have been received.
      - 2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      - 3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_.

### DETAILED ACTION

1. This office action is a response to the restriction requirement filed on 4/8/2004.

#### *Response to the Restriction Requirement*

2. Applicant's election with traverse of Group III, claims 32, 41, 42 and 46-60, in Paper No. 9 is acknowledged. The traversal is on the ground(s) that all the claims as filed would not require additional searching, not place any undue burden on the patent office. This is not found persuasive because these inventions (Group I, II and III) are distinct for the reasons given last office action on Paper No. 7 and also, Group I and II does not teach a process of attaching an actuator assembly on the base plate after the injection molding and also have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. However, examiner agrees with the applicant that further election of species of Group III was not clear on Paper No. 7 so that the requirement of the election of species of Group III is withdrawn hereby.

The requirement is still deemed proper and is therefore **made FINAL**.

3. Claims 1-31, 34-40 and 43-45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.
4. Upon further consideration, the elected Group III, claims 32, 41, 42 and 46-60, is required further restriction under 35 U.S.C. 121:

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- I. Claims 32 and 60, drawn to a method of manufacturing a base plate, classified in class 29, subclass 830.
- II. Claims 41, 42 and 46-52, drawn to a method of manufacturing miniature hard disk drive, classified in class 39, subclass 603.06.
- III. Claims 53-59, drawn to a method of manufacturing hard disk drive, classified in class 39, subclass 603.03.

The inventions are distinct, each from the other because of the following reasons:

5. Inventions Group I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group I has separate utility such as metal strip to be formed into a plurality of base plates is fed continuously through an injection molding machine to sequentially injection mold the monolithic body on each base plate. Group II has separate utility such as substantially encapsulating the stator, the actuator assembly housing and the base plate with a phase change material to form a unitized body. Group III has separate utility such as providing a metal strip which comprises at least one base plate and one cover and injection molding a phase change material to form a monolithic body on the base plate and cover See MPEP § 806.05(d).
6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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7. If applicant elects Group II, then Group II contains claims directed to the following patentably distinct species of the claimed invention:

Species A, drawn to substantially encapsulating the stator, the actuator assembly housing and the base plate with a phase change material to form a unitized body of claims 41 and 42.

Species B, drawn to injection molding a monolithic body layer of phase change material unitizing said stator to the base plate of claims 46-48.

Species C, drawn to injection molding a monolithic body layer of phase change material to unitize said spindle motor assembly to the base plate of claims 49 and 20.

Species D, drawn to injection molding a monolithic body layer of phase change material unitizing said actuator assembly to the base plate of claims 51 and 52.

Currently, there is no generic claim.

If applicant elects Group III, then Group III contains claims directed to the following patentably distinct species of the claimed invention:

Species E, drawn to encapsulating said spindle motor assembly with a phase change material unitizing the spindle motor assembly with the base plate of claim 54.

Species F, drawn to encapsulating said actuator assembly with a phase change material unitizing the actuator assembly with the base plate of claim 55.

Currently, claim 53 is a generic claim.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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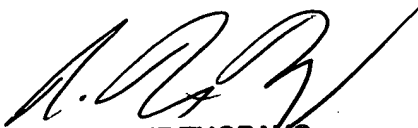
9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul D Kim whose telephone number is 703-308-8356. The examiner can normally be reached on Tuesday-Friday between 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

pdk

  
**A. DEXTER TUGBANG**  
**PRIMARY EXAMINER**